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No. 95-45

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1995

FRED L. PIRKLE and THERM-OMEGA-TECH, INC.,
Petitioners,

vs.

OGONTZ CONTROLS COMPANY and THOMAS M. KENNY,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

AMICUS CURIAE BRIEF OF INVENTORS CLUBS OF AMERICA IN SUPPORT OF PETITIONERS

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Respondents.

AMICUS CURIAE BRIEF OF INVENTORS CLUBS OF AMERICA

Pursuant to Supreme Court Rule 37 and with the written consent of the parties, a copy of which is on file with the Court, the Inventors Clubs of America respectfully submits this *amicus curiae* brief in support of the grant of the petition for a writ of certiorari.

STATEMENT OF INTEREST

The Inventors Clubs of America ("ICA") is a national association of clubs whose members include approximately 6,000 inventors, scientists, manufacturers, and others involved in problem-solving and inventing. Founded in 1935 and headquartered in Atlanta, Georgia, ICA seeks to stimulate inventiveness and help inventors in all phases of their work, including patenting, development, manufacturing, marketing and advertising. ICA works to prevent abuses of the individual inventor (such as the theft of ideas) to create new industry, and to lower the tax rate. Additionally, ICA conducts research and educational programs, sponsors children's services and professional training, and operates a charitable program and speakers' bureau.

ICA has no financial interest in either the parties to or the outcome of this case. ICA's interest, on behalf of its constituent club members, is to achieve a correct and consistent interpretation and application of the law relating to patents, and in particular to preserve the right to have juries decide disputed issues of fact that arise with respect to patent claim interpretation.

SUMMARY OF ARGUMENT

The day after its landmark *en banc* decision in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995), *petition for cert. filed*, (U.S. July 3, 1995) (No. 95-26), the Federal Circuit in this case entered a judgment that neither applied the *Markman* holding nor addressed

the Seventh Amendment issue raised by the district court's submission of claim interpretation to different juries that respectively decided validity and infringement. If it is to be the law of the land that claim interpretation is in *all* cases to be decided as a matter of law, initially by the trial judge and thereafter on *de novo* review by the Federal Circuit, inventor-litigants are entitled to have that law of the land applied in their cases. More importantly, although the judgment below is flawed whether claim interpretation is for judge or jury, ICA wishes to stress the importance to inventors and small manufacturers of having juries decide disputed issues regarding the meaning of patent claim terms based on the testimony of persons skilled in the particular art in question. The issue is cleanly presented in this case and it is ripe for an authoritative ruling by this Court.

The current position of the Federal Circuit *en banc*, that in patent jury trials the judge should weigh the evidence and decide disputed facts regarding what claim terms would have meant to skilled artisans, is wholly at odds with the Seventh Amendment jurisprudence of this Court. This Court should grant review and reenfranchise those interested in patents with their historic right to have the critical issue of claim interpretation decided by juries, based on the testimony of persons who are skilled in the relevant art.

ARGUMENT

I. Supreme Court Review Is Needed To Preserve The Rights Of Inventors And Other Patent Litigants To Have Factual Issues Regarding The Scope Of Patent Claims Decided By Juries

In order to promote the progress of science and useful arts, the framers of the Constitution empowered Congress to pass laws securing for limited times to inventors the exclusive right to their discoveries. U.S. Const. art. I, §8, cl. 8.[1] "The economic philosophy behind [this clause] is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and Useful Arts.'" *Mazer v. Stein*, 347 U.S. 201, 219 (1954). A patent is a means of protecting the fruit of an inventor's genius. The grant of a patent confers a special privilege to be free from competition in the practice of the invention. *Mercoid Corp. v. Mid-Continent Investment Co.*, 320 U.S. 661, 665 (1944). This privilege, however, is limited to the invention that the patent defines. *Id.* at 666.

It is a fundamental precept of patent law that the scope of the protected invention is defined by the language of

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[1] Article I, section 8, clause 8 provides that "Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

the patent "claims".[2] *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 619 (Fed. Cir. 1995) citing *Yale Lock Mfg. Co. v. Greenleaf*, 117 U.S. 554, 559 (1886). The determination of the meaning of the language of the claims, commonly referred to as claim interpretation, is a critical exercise in a patent case. An improper interpretation of the claims will distort the entire decisional process on the issues of both patent validity and patent infringement. *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d, 878, 885 (Fed. Cir. 1988). Indeed, a decision on the meaning of the words used in the claim is usually outcome determinative. *See Markman*, 52 F.3d at 989 (Mayer, J., concurring) ("[T]o decide what the claim means is nearly always to decide the case."). Absent intervention by this Court, the Federal Circuit will have effectively "eject[ed] juries from infringement cases." *Id.*

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[2] A patent application consists of three parts: the specification, the drawings, and the oath. *See* 35 U.S.C. §111(a)(2). The specification includes both a general written description of the invention and one or more "claims." A claim is simply an ennumerated paragraph that precisely describes the subject matter that the applicant regards as his or her invention. *Id.* at §112. It is the claims that determine the scope of patent protection that an invention receives.

That there is a Seventh Amendment[3] right to a jury trial in a patent infringement suit seeking monetary damages would appear to be well-settled as a general proposition. *See Markman*, 52 F.3d at 984 (the concurring and dissenting judges agreed with this basic thesis).[4] This conclusion is hardly surprising. "The founders of our Nation considered the right of trial by jury in civil cases an important bulwark against tyranny and corruption, a safeguard too precious to be left to the whim of the sovereign, or, it might be added, to that of the judiciary." *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 343 (1979) (Rehnquist, J. dissenting) (footnote omitted). The constitutionally guaranteed right to a jury trial "has always been an object of deep interest and solicitude, and every encroachment upon it has been watched with great jealousy." *Parsons v. Bedford*, 28 U.S. (3 Pet.) 433, 446 (1830). Indeed, "[m]aintenance of the jury as a fact-finding body is of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be

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[3] The Seventh Amendment to the Constitution provides:

> In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury, shall be preserved, and no fact tried by a jury shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law.

[4] In 1791 all patent cases in this country were tried at law; it was not until 1819 that equity jurisdiction was extended to patent cases. *See Root v. Railway Co.*, 105 U.S. 189, 191-93 (1881); *Tights, Inc. v. Stanley*, 441 F.2d 336, 342-43 (4th Cir.), *cert. denied*, 404 U.S. 852 (1971).

scrutinized with the utmost care." *Dimick v. Schiedt*, 293 U.S. 474, 486 (1935).[5]

The function assigned to the jury in the federal system, and preserved by the Seventh Amendment, is to decide disputed issues of fact. *See Byrd v. Blue Ridge Rural Electric Cooperative, Inc.*, 356 U.S. 525, 538-39 (1958). The Seventh Amendment "requires that questions of fact in common law actions shall be settled by a jury, and that the court shall not assume directly or indirectly to take from the jury or to itself such prerogative." *Walker v. New Mexico & Southern Pacific Railroad Co.*, 165 U.S. 593, 596 (1897).[6] The right to jury decision on the meaning of patent claims, therefore, depends in large part upon whether disputed issues of fact are presented. *Cf. Ex parte Peterson*, 253 U.S. 300, 310 (1920) ("No one is entitled in a civil case to trial by jury unless and except so far as there are issues of fact to be determined.")

Patent claims are to be interpreted as they would have been understood by "one of ordinary skill in the art at the time of the invention." *Markman*, 52 F.3d at 986. It is fair to say that "[a] judge is not usually a person conversant in the particular technical art involved and is

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[5] This passage has been quoted as the basis for the grant of certiorari where lower courts have attempted to curtail Seventh Amendment rights. *See Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 501 (1959).

[6] The Seventh Amendment extends equally to statutory causes of action where legal rights and remedies are at stake. *See Chauffeurs, Teamsters and Helpers Local No. 391 v. Terry*, 494 U.S. 558, 564-65 (1990).

not the hypothetical person skilled in the art to whom a patent is addressed." *Id.* This reality has formed the predicate for the Court to reject an argument that the trial judge, rather than the jury, should have defined the claimed invention, and to query: "How could the Judge know this as matter of law?" *Silsby v. Foote*, 55 U.S. (14 How.) 218, 226 (1852).

Because the meaning of claim language in the context of a particular art is not within the ordinary knowledge of either judge or jury, it is the routine practice to present extrinsic evidence such as prior art and expert testimony of those who were skilled in the pertinent art at the time of the invention.[7] Indeed, it is precisely because there will be competing extrinsic evidence that the meaning of the patent claim terms must be decided by the jury. *See Silsby*, 55 U.S. (14 How.) at 226 (determining the claimed invention was "a question for the jury, upon the evidence of experts, or an inspection by them of the machines, or upon both. . . ."); *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 815-16 (1870) (ascertaining the character of the thing invented, based on the patent specification and evidence *in pais*, was a jury question); *Turrill v. The Michigan Southern & Northern Indiana Railroad*, 68 U.S. (1 Wall.)

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[7] The failure to allow expert testimony, regarding how those skilled in the art would interpret the claim, has been held to constitute an abuse of discretion. *See Moeller v. Ionetics, Inc.*, 794 F.2d 653, 657 (Fed. Cir. 1986); *see also Seymour v. Osborne*, 78 U.S. (11 Wall.) 516, 546 (1871) ("Cases doubtless arise where the language of the specification and claim . . . is so interspersed with technical terms and terms of art that the testimony of scientific witnesses is indispensable to a correct understanding of its meaning. [I]t would undoubtedly be error in the court to reject the testimony. . . .").

491 (1863) (whether or not the invention as claimed was found in the prior art was a question for the jury, and not for the court); *Battin v. Taggert*, 58 U.S. (17 How.) 74, 85 (1854) (it was for the jury to decide whether that which was claimed in a renewed patent was for the same invention as in the original patent); *Wood v. Underhill*, 46 U.S. (5 How.) 1, 5-6 (1847) (whether a claim description was sufficiently clear to enable one skilled in the art to compound and use the invention was for the jury to decide from the evidence of persons skilled in the art).[8] This same proposition can also be deduced by negative inference from other decisions of the Court. *See, e.g., Market Street Cable Railway Co.* v. *Rowley*, 155 U.S. 621, 625 (1895) ("No extrinsic evidence was given or needed to explain terms of art. . . . The question was, then, one of pure construction and not of evidence, and consequently was matter of law for the court, without any auxiliary fact to be passed upon by the jury.").

More recent precedent of the Court also leads to the conclusion that claim interpretation is a question of fact for the jury. Before there can be a determination of how

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[8] There is also a substantial body of pre-*Markman* Federal Circuit precedent that follows the teachings of this Court that claim interpretation is for the jury when conflicting evidence has been presented. *See, e.g., Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1206 (Fed. Cir. 1992), *cert. denied*, 113 S. Ct. 976 (1993); *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H.*, 945 F.2d 1546, 1549-50 (1991); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985); *Bio-Rad Laboratories, Inc. v. Nicolet Instrument Corp.*, 739 F.2d 604, 613-14 (Fed. Cir.), *cert. denied*, 469 U.S. 1038 (1984); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir.), *cert. denied*, 469 U.S. 1037 (1984).

claim terms would have been understood by those of ordinary skill in the pertinent art at the time of the invention, there must first be a preliminary resolution of what the level of ordinary skill in the pertinent art is. This preliminary question is "a basic factual inquiry." *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Because this is a factual inquiry, a litigant in a patent suit at law is guaranteed the right to have it decided by a jury.

The present state of the law in the Federal Circuit derogates the Seventh Amendment and contravenes this Court's precedent. Supreme Court review is needed to preserve the rights of inventors and all other patent litigants to have factual issues regarding the scope of patent claims decided by juries.

II. If Claim Interpretation Is Now In All Cases To Become A Question For The Court Subject To *De Novo* Review By The Federal Circuit, The Policies Of Predictability And Consistency That Gave Birth To This Rule Equally Mandate That The Rule Be Applied In *All* Cases, And That The Federal Circuit's Claim Interpretation Be Set Forth In A Written Opinion

Although ICA finds itself in accord with the substantive views expressed by Judge Newman in dissent in *Markman*, no enlightened system of jurisprudence can tolerate the refusal by some to apply the law as established for the Circuit by the Court *en banc*. Unless and until *this Court* rules otherwise, *en banc* precedent is binding and must be applied in all subsequent decisions by panels of the Court

of Appeals and district courts alike. *See, e.g., FDIC v. Bowles Livestock Commission Co.*, 937 F.2d 1350, 1354 (8th Cir. 1991).

The policies of consistency and predictability, that are believed by some to be furthered by the *Markman* majority rule, equally mandate application of the *Markman* rule in this case if this Court does not change that rule.[9] Moreover, the Federal Circuit's interpretation of the meaning of patent claims will be of no utility for future cases unless set forth in an opinion. Absent such a written claim interpretation, there cannot even arguably be "a permanent and universal definition of [the inventor's] rights under the patent." *Markman*, 52 F.3d at 979.[10]

CONCLUSION

ICA respectfully urges the Court to grant writs in this case and in *Markman*, No. 95-26, and to restore the right

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[9] Except in certain defined circumstances not here applicable, "federal cases should be decided in accordance with the law existing at the time of decision." *Goodman v. Lukens Steel Co.*, 482 U.S. 656, 662 (1987).

[10] When such judicial claim interpretation involves a resolution of competing extrinsic evidence, it would seem that any permanence of such an interpretation can only be applied *against* the inventor and not in favor of the inventor against other infringers. *See, e.g., Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U.S. 313 (1971). Even when asserted against the inventor or patentee, a prior "scope of the claim" determination may not be given collateral estoppel effect. *See Jackson Jordan, Inc. v. Plasser American Corp.*, 747 F.2d 1567, 1577-78 (Fed. Cir. 1984).

to have disputed issues of fact regarding the meaning of patent claim terms decided by juries.

Respectfully submitted,

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